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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,654	10/24/2003	H. Donald Schwartz	D0419.70008US00	9919

7590 12/19/2005  
David Wolf  
Wolf, Greenfield & Sacks, P.C.  
600 Atlantic Avenue  
Boston, MA 02210

EXAMINER
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RAEVIS, ROBERT R

ART UNIT	PAPER NUMBER
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2856

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/692,654

Applicant(s)

SCHWARTZ, H. DONALD

Examiner

Robert R. Raevis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
  - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some \* c) ☐ None of:
    - 1. ☐ Certified copies of the priority documents have been received.
    - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  - Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)
  - Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Claims 1-6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, what is "sized, shaped...rod passes" (line 4-5)? Is it the rod itself, or is it the passage? Should the word "therethrough" (line 4) read – therethrough, the cylinder --?

Claim 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Bach.

As to claims 1,3, the provisional application of Bach teaches (Figure 4) a block (Cylinder-Upper) having a passage extending therethrough; a rod (Primary Piston), that passes into the channel block passage; a cylinder (Secondary Piston) having an axially extending passage supporting a spring, the cylinder passing into the block from the end opposite the end into which the rod passes; a chamber defined by the inside wall of the block, the outer perimeter of the rod, the outer perimeter of the cylinder, and having a volume which is variable during the pipetting ("pipettor" on the fourth line of the first page of the written specification of the provisional) operation of the pipette, with a first part of the chamber being variable by relative movement of the block relative to the fixed relative positions of the rod and cylinder (note the "secondary piston can follow the primary piston" (lines 3-4 from bottom of p. 1 of provisional application), suggestive that the rod and cylinder are moving together relative to the block)), and with a second part of the chamber variable by *additional* movement of the cylinder relative to the fixed

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position of the block (both the rod and cylinder are still in contact as they move upwards relative to the block) and by even additional movement of the cylinder relative to the fixed position of the rod (as the rod moves away from the cylinder, while both the cylinder and block are both stationary relative to the moving rod). In effect, the "variable" (line 2 from last of Claim 1) portion of the "second part of the chamber" is not related to the "fixed relative positions" in a manner that defines the claim from Bach.

As to claim 2, note that when the rod moves relative to fixed positions of the block and cylinder, that the pump volume may increase, allowing for a third part.

As to claim 4, note the vertically oriented groove in the rod in Figure 4, the groove connecting "Inlet Port" with the remaining volume of the liquid in the block. At least the diameter of the rod at this point is less than that of the inner diameter of the channel block.

Note that claim 1 would be distinguishable over Bach if amended to insert the word –simultaneously—were after "relative to the" (last line of claim 1). This would make it clear that the "second part of the chamber" (line 2 from bottom of claim 1) were variable when both the block and rod are fixed, and only the cylinder is moving. In the alternative, Applicant may consider replacing "therethrough" (line 4) with – extending entirely through the cylinder, and --; as the aperture of the cylinder (i.e. secondary piston) that supports Bach's spring is not entirely through the cylinder. These minor comments may aid Applicant in fully comprehending the outstanding art rejection.

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Claims 5 and 6 would be allowable if (1) rewritten in independent form including all of the limitations of the base claim and any intervening claims, **and** (2) amended in a manner consistent with the suggestion (Should the word "therethrough" (line 4) read – therethrough, the cylinder --? ) provided in the second paragraph of p. 2 of this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert R. Raemis whose telephone number is 571-272-2204. The examiner can normally be reached on Monday to Friday from 5:30am to 3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams, can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*RR*

*RAEMIS*